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OFFICE OF PETITIONS

In re Application of
Michael Zasloff et al.
Application No. 10/824,661
Filed: April 15, 2004
Attorney Docket No. 036870-5045-14
Title: AMINOSTEROL COMPOUNDS
USEFUL AS INHIBITORS OF THE
SODIUM/PROTON EXCHANGER (NHE),
PHARMACEUTICAL METHODS AND
COMPOSITIONS EMPLOYING SUCH
INHIBITORS, AND PROCESSES FOR
EVALUATING THE NHE-INHIBITORY
EFFICACY OF COMPOUNDS

DECISION ON PETITION UNDER
37 C.F.R. §1.182

This is a decision on the "Petition for Acceptance of Drawings," which is properly treated as a petition under 37 C.F.R. §1.182, filed August 30, 2004, requesting that the above-identified application be accorded a filing date of April 15, 2004, with Figures 17A and 17B as part of the original disclosure of the application.

The application was deposited on April 15, 2004. However, on June 28, 2004, the Office of Initial Patent Examination (OIPE) mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (notice) stating that the application had been accorded a filing date, and advising applicants that it appeared as though the application was deposited without Figures 17A and 17B. The notice further indicated that the basic filing fee, the fee associated with the late submission of the filing fee, a substitute specification, and replacement drawings would be required. The notice set a two-month period for response.

On August 30, 2004, the instant petition was filed, along with Figures 17A and 17B, a copy of the notice, replacement drawings, various fees (including the fee for the submission of the instant petition) and a substitute specification.

Petitioner has not contended that this page was present on filing. While it appears that this page was omitted on filing, Petitioner contends that it was constructively included, through incorporation by reference.

The Office allows an applicant to rely upon an incorporation by reference of a parent

application when a portion of the child application has been inadvertently omitted. The specification indicates that the instant application is a continuation of application 09/985,417 and the Utility Patent Application Transmittal sheet indicates that the entire disclosure of the parent application is incorporated by reference.

It is noted that 09/985,417 is a continuation of 09/198,486, which is a continuation of 08/487,443.

Section 201.06(c) of the MPEP sets forth, in part:

an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition (emphasis added) provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

For these reasons, the petition under 37 CFR §182 is **DISMISSED**.

The application will receive a filing date of April 15, 2004. However, Figures 17A and 17B submitted with the instant petition will not be entered.

If Petitioner desires for the missing pages to be included, he should submit these pages via an amendment. This amendment, of course, will not be entered until it has been reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

The original application papers will include only those application papers present on the date of deposit.

The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of April 15, 2004, using only the application papers filed on that date.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

¹ See MPEP 608.02(a).